

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-22 are now pending in this application.

In the outstanding Office Action, claims 1-5, 7-11, 15-18, 21, and 22 were rejected under 35 U.S.C. § 103(a) as obvious over Yates, U.S. Patent No. 4,443,638, in view of Miyazawa, EP 0272608. Claims 6, 12-14, 19, and 20 were rejected under 35 U.S.C. § 103(a) as obvious over Yates, in view of Miyazawa, and further in view of Ueda, U.S. Patent No. 5,865,967.

Claims 1-5, 7-11, 15-18, 21, and 22 were rejected under 35 U.S.C. § 103(a) as obvious over Yates, U.S. Patent No. 4,443,638, in view of Miyazawa, EP 0272608. Applicants respectfully traverse these rejections, as the Office has failed to state a prima facie case of obviousness.

In order to make a prima facie case of obviousness, the combined references must disclose the elements of the claimed invention. In addition to disclosing the elements, there must be some motivation or suggestion to combine the references. In the present case, it is clear that there is no such motivation or suggestion to combine Yates with Miyazawa to result in the claimed invention. Rather, the Yates reference actually teaches away from combination with the Miyazawa reference.

Yates teaches a process for preparing alcohols from olefins using rhodium concentrations no greater than 20 ppm. Yates, col. 2, line 45 to col. 3, line 8. Yates, in its

discussion of the background of the invention, notes that the prior art taught similar processes using 100 ppm and 1000 ppm of rhodium as the catalyst. Said Yates:

Not only does the instant invention necessitate much smaller concentrations of rhodium *but it also would not operate at concentrations this large*.

Yates, col. 1, lines 65-68 (emphasis added). Miyazawa, contrary to Yates, teaches that the “catalyst concentration in the reaction zone is usually from 1 to 500 mg/liter, preferably from 2 to 100 mg/liter, as rhodium”, which converts to 1 to 500 ppm of rhodium. Clearly, the vast majority of the range of rhodium concentration disclosed in Miyazawa would not work in combination with Yates, according to Yates itself. As the Federal Circuit stated in *Tec Air, Inc. v. Denso Mfg. Mich., Inc.*, references whose combination would produce a “seemingly inoperative device” teach away from such a combination and “thus cannot serve as predicates for a prima facie case of obviousness”. 192 F.3d 1353, 1360, 52 USPQ2d 294 (Fed. Cir. 1999). In view of the teaching of Yates that rhodium concentrations of greater than 20 ppm would not work in combination with the Yates invention, one skilled in the art would not be led to combine the Yates reference with the Miyazawa reference, which taught rhodium concentrations up to 500 ppm.

Claim 1, from which claims 2-22 all depend directly or indirectly, is directed to a process for preparing aldehydes and alcohols. The process includes subjecting olefins having 6-20 carbon atoms to a rhodium-catalyzed hydroformylation at a pressure in the range of 150 to 270 bar. The Yates reference does not teach the pressure limitation, instead teaching a maximum pressure of about 2000 psig (equal to 138 bar). As noted above, one skilled in the art would not be led to combine Yates with Miyazawa to reach the claimed invention. With no teaching or suggestion of the pressure limitation, a prima facie case of obviousness is not made. Accordingly, Applicants respectfully request the withdrawal of the rejections of claims 1-5, 7-11, 15-18, 21, and 22 as obvious over Yates in view of Miyazawa.

Claims 6, 12-14, 19, and 20 were rejected under 35 U.S.C. § 103(a) as obvious over Yates, in view of Miyazawa, and further in view of Ueda, U.S. Patent No. 5,865,967.

Applicants respectfully traverse these rejections as the Office has failed to state a prima facie case of obviousness. All of these claims depend directly or indirectly from claim 1, which, as discussed above, should be allowed. The addition of the Ueda reference does not remedy the deficiencies, as Ueda also fails to teach or suggest the claimed pressure range. Accordingly, Applicants respectfully request the withdrawal of claims 6, 12-14, 19, and 20 as obvious over Yates, in view of Miyazawa, and Ueda.

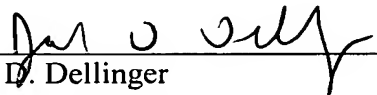
Consequently, in light of the above discussion, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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